

REMARKS

This responds to the Office Action mailed on September 22, 2005, and the references cited therewith.

Claims 1-5, 8-9, 21-26, and 62-67 are amended, claim 7 is canceled, claim 85 is added; and claims 10-20, 29-61 and 70-84 are withdrawn; as a result, claims 1-6, 8-9, 21-28, 62-69, and 85 are now pending in this application.

§102 Rejection of the Claims

Claims 21-27 were rejected under 35 U.S.C. § 102(e) for anticipation by Hurvig (U.S. Publication No. 2004/0205243).

Applicants respectfully traverse this rejection.

Hurvig teaches an infrastructure which provides a distributed family of identity servers to manage identity-related personal information. However, the system described in Hurvig is clearly directed to an implementation that is not site-based. Specifically, Hurvig describes his implementation as distinct from site-based implementations (e.g. online commerce sites). In particular, Hurvig states:

[0009] It is a goal of the present invention to provide an infrastructure that addresses these diverse areas, and which allows for a distributed family of identity servers that can be spread though-out the Internet.

[0010] This is in very stark contrast to most present initiatives on the Internet, which are with few exceptions "site-based", that is, based around a single web-site with a single web-site address (URL, Uniform Resource Locator). Each site-based solution is typically to a large extent proprietary, and cannot interoperate with other services.

[0011] More fundamentally, any site-based approach requires that any user of the service knows where it is hosted. So, for instance, to schedule an appointment in another person's calendar, I need to know not only the identity of that person, but also where the calendar is hosted. The present invention inverts this relationship, so that I--or my identity--go directly to the other person's identity, at which point it is simple to chose the application, namely his calendar. (emphasis added, Hurvig paras. 9 - 11).

Claim 21 is clearly directed to “facilitate access to services on an online commerce site”. Claim 21 is thus clearly site-based. Such a limitation puts this claim, and those dependent upon it, outside the realm of Hurvig. Further, as can be seen in Figs. 2 & 4-8 of Hurvig along with the related textual descriptions, Hurvig provides identity servers at identity sites (e.g. Identity site A), that store identity information for a plurality of users (Hurvig paras. 131-141). Visitors to these identity sites can obtain user identity information and use various identity services (e.g. address books). However, these identity sites do not themselves provide online commerce services. Hurvig is an identity management technology. Claim 21 is directed to an online commerce site access technology. Claim 21 has been further amended to clearly define the invention as distinguished from Hurvig. In particular, Claim 21 includes:

receiving a service request from a client for access to a service on a server supporting the online commerce site, the service request including at least a portion of an access rule associated with the client and the server, the access rule having been previously provided to the client by the online commerce site;

Hurvig does not describe a system in which a client makes a service request to a server supporting an online commerce site, in which the service request includes at least a portion of an access rule associated with the client and the server, the access rule having been previously provided to the client by the online commerce site. This limitation clearly distinguishes Claim 21 from Hurvig. Thus, the §102(e) rejection of Claim 21 should be withdrawn.

Claims 22 and 26-28 are dependent upon Claim 21 and thus are allowable for the same reasons set forth above for Claim 21. The §102(e) rejection of Claims 22 and 26-27 should be withdrawn. Claims 23-25 are now dependent upon Claim 1 and are allowable for the reasons set forth below.

§103 Rejection of the Claims

Claim 28 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hurvig as applied to claims 21-27 above.

Claims 1-9 and 62-69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Romero et al. (U.S. Publication No. 2002/0069279).

Applicants respectfully traverse these rejections.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). As part of establishing a *prima facie* case of obviousness, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The court in *Fine* stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."

Id. (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

"In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed.Cir. 1991))." *M.P.E.P.* §2142. (emphasis added.)

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness, because there is no motivation to combine Hurvig and Romero to arrive at the claimed subject matter. In particular, (a) there is no evidence of record to suggest the proposed combination and (b) Hurvig simply teaches away from Applicants' claims.

a. There is no evidence of record to suggest the proposed combination

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection. *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

Specifically, the Federal Circuit stated: “[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority. *Id.* at 1434. This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner. *Id.* Deficiencies in the evidentiary record cannot be cured by general conclusions such as “general knowledge” or “common sense.” *Id.* Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record. *Id.* Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant’s dependent claims, the claims should be allowed.

The Office Action appears to rely on Romero for the online auction server element of claim 28. The Office Action also appears to rely on Romero and an uncited reference for the step of “transmitting an identifier for the first server”, as formerly included in Claim 1. Firstly, Claim 1 has been amended to include, “generating an access rule associated with the client and the first server; and transmitting the access rule to the client”. As correctly stated in the Office Action, Romero does not specifically teach the step of transmitting an identifier for the first server. Similarly, Romero does not teach transmitting an access rule to the client as presently claimed. However, the Office Action further relies on unsupported, conclusory statements to close holes in Romero. Specifically, the Office Action asserts that it would have been obvious to a person of ordinary skill in the art to provide the server identifier to the user in the Romero system. For independent claims 1, 21, 62 and 85, the conclusion of obviousness over Hurvig in view of Romero advanced by the Office Action relies on a motivation taken from unknown authority, rather than the prior art. Indeed, the Office Action cited no prior art teaching as the source for the motivation. No support, evidence, or suggestion in the evidentiary record is provided for this assertion. As such, the rejection of the presently presented claims on this basis is improper.

For this reason, the Office Action failed to establish a *prima facie* case of obviousness. Accordingly, independent claims 1, 21, 62 and 85 are patentably distinguishable over the cited references, and Applicant respectfully requests that the rejection be withdrawn.

b. In addition, Hurvig simply teaches away from Applicant's claims

Motivation to combine or modify the prior art is lacking when the prior art teaches away from the claimed combination. A reference may be said to teach away when the reference suggests a path direction that is divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Again, Hurvig teaches an infrastructure which provides a distributed family of identity servers to manage identity-related personal information. However, the system described in Hurvig is clearly directed to an implementation that is not site-based. Specifically, Hurvig describes his implementation as distinct from site-based implementations (e.g. online commerce sites). As such, Hurvig teaches away from the claim language of independent claims 1, 21, 62, and 85. One of ordinary skill in the art would therefore not have been motivated to combine Hurvig and Romero. The assertion in the Office Action that one of ordinary skill in the art would have been motivated to modify Hurvig's system to improve the functionality of the system does not specifically address the system modifications needed or suggested by Hurvig or Romero to arrive at the presently claimed invention.

Because Hurvig teaches away from the claim language of independent claims 1, 21, 62, and 85, the Office Action simply does not disclose motivation or suggestion to modify Hurvig as suggested in the Office Action.

Therefore, independent claims 1, 21, 62, and 85 are patentably distinguishable over Hurvig in view of Romero. Nothing within the teachings of Hurvig or Romero remedies the deficiencies as discussed above.

Applicants respectfully request withdrawal of all pending rejections based on 35 U.S.C. §103(a) in view of the arguments above.

Claims 2-6, 8-9, 22-28, and 63-69 depend, directly or indirectly, on one of claims 1, 21, 62, or 85, and are patentably distinguishable over the references respectively cited against them in the Office Action, for the reasons set forth above. These dependent claims are also patentable in view of the additional elements that they provide to the patentable combination.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCOTT LEAHY ET AL.

By their Representatives,

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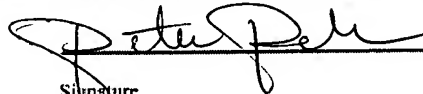
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